



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,022	01/15/2002	Kiyotaka Matsumoto	381NP/50853	7876

7590 05/18/2006  
CROWELL & MORING, LLP  
P.O. Box 14300  
Washington, DC 20044-4300

EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/045,022	MATSUMOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vanel Frenel	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1152002</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the application filed on 1/15/02/ Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al (6,208,973) in view of Bednarek (6,965,868).

(A) As per claim 1, Boyer discloses a point managing method wherein terminals of individual members of multiple service users and service providers registered as members, and terminals of a hosting business association are connected with communication mean, member information recording media which can be attached to the terminals of the individual members are delivered (See Boyer, Col.12, lines 6-56).

Boyer does not explicitly disclose that the method having prescribed points are given to the service provider through said terminal and said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points.

However, this feature is known in the art, as evidenced by Bednarek. In particular, Bednarek suggests that the method having prescribed points are given to the service provider through said terminal and said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points (See Bednarek, Col.43, lines 60-67 to Col.44, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bednarek within the system of Boyer with the motivation of providing existing reward programs such as airline reward programs, credit card reward programs point of purchase reward, internet loyalty reward programs and like .Base points (BP) can be any form of accumulated reward, including for example airline miles, cash awards, ClickRewards, point, accumulated winnings, accumulated losses, etc. (See Bednarek, Col.18, lines 61-67).

(B) As per claim 2, Boyer discloses a point managing method wherein terminals of individual members of multiple service users and service providers registered as members, and terminals of an operating business association are connected with communication mean for communicating, said operating business association or its agent delivers member information to said terminals of the individual members, or delivers member information recording media which can be attached to terminals of the individual members (See Boyer, Col.12, lines 6-56).

Boyer does not explicitly disclose that the method having prescribed points are given to the service provider through said terminal and/or said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points.

However, this feature is known in the art, as evidenced by Bednarek. In particular, Bednarek suggests that the method having prescribed points are given to the service provider through said terminal and/or said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points (See Bednarek, Col.43, lines 60-67 to Col.44, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bednarek within the system of Boyer with the motivation of providing existing reward programs such as airline reward programs, credit card reward programs point of purchase reward, internet loyalty reward programs and like .Base points (BP) can be any form of accumulated reward, including for example airline miles, cash awards, ClickRewards, point, accumulated winnings, accumulated losses, etc. (See Bednarek, Col.18, lines 61-67).

(C) As per claim 3, Boyer discloses a point managing method wherein terminals of individual members of multiple service users and service providers registered as

Art Unit: 3626

members, and terminals of a hosting business association are connected with the Internet, member information recording media which can be attached to the terminals of the individual members are delivered (See Boyer, Col.12, lines 6-56).

Boyer does not explicitly disclose that the method having prescribed points are given to the service provider through said terminal by means of writing to said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points.

However, this feature is known in the art, as evidenced by Bednarek. In particular, Bednarek suggests that the method having prescribed points are given to the service provider through said terminal by means of writing to said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points (See Bednarek, Col.43, lines 60-67 to Col.44, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bednarek within the system of Boyer with the motivation of providing existing reward programs such as airline reward programs, credit card reward programs point of purchase reward, internet loyalty reward programs and like .Base points (BP) can be any form of accumulated reward, including for example airline miles, cash awards, ClickRewards, point, accumulated winnings, accumulated losses, etc. (See Bednarek, Col.18, lines 61-67).

(D) As per claim 4, Boyer discloses a point managing method wherein terminals of individual members of multiple service users and service providers registered as members, and terminals of an operating business association are connected with the Internet for communicating, said operating business association or its agent delivers member information to said terminals of the individual members, or delivers member information recording media which can be attached to terminals of the individual members (See Boyer, Col.12, lines 6-56).

Boyer does not explicitly disclose that the method having prescribed points are given to the service provider through said terminal and/or said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points.

However, this feature is known in the art, as evidenced by Bednarek. In particular, Bednarek suggests that the method having prescribed points are given to the service provider through said terminal and/or said recording medium when the service user receives a service from the service provider, and a service is received, or an article is purchased or lent based on point conversion according to said accumulated points (See Bednarek, Col.43, lines 60-67 to Col.44, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bednarek within the system of Boyer with the motivation of providing existing reward programs such as airline reward programs, credit card reward programs point of purchase reward, internet loyalty reward programs

and like .Base points (BP) can be any form of accumulated reward, including for example airline miles, cash awards, ClickRewards, point, accumulated winnings, accumulated losses, etc. (See Bednarek, Col.18, lines 61-67).

(E) As per claim 5, Boyer discloses the point managing method wherein said recording media are IC cards or cellular phones, and a member certificate function and/or a member authentication function are added to said recording media (See Boyer, Col.6, lines 40-57).

(F) As per claim 6, Boyer discloses the point managing method wherein the service provider is a caregiver, and the service user is a care receiver (See Boyer, Col.6, lines 14-39).

(G) As per claim 7, Boyer discloses a point management method wherein both service users and service providers are members, an electronic medium is issued to individual members, a need of the service user and a service which the service provider can provide are matched, the matching result is reported to both the subject members (See Boyer, Col.10, lines 35-52).

Boyer does not explicitly disclose that the method having points are provided for the service provider according to a conducted service, the points can be used at available participant stores, and the used points are settled by an operating body.

However, this feature is known in the art, as evidenced by Bednarek. In



Art Unit: 3626

particular, Bednarek suggests that the method having points are provided for the service provider according to a conducted service, the points can be used at available participant stores, and the used points are settled by an operating body (See Bednarek, Col.43, lines 60-67 to Col.44, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bednarek within the system of Boyer with the motivation of providing existing reward programs such as airline reward programs, credit card reward programs point of purchase reward, internet loyalty reward programs and like .Base points (BP) can be any form of accumulated reward, including for example airline miles, cash awards, ClickRewards, point, accumulated winnings, accumulated losses, etc. (See Bednarek, Col.18, lines 61-67).

(H) As per claim 8, Boyer discloses the point management method wherein issuing said electronic medium is delivering an IC card (See Boyer, Col.6, lines 40-57).

(I) As per claim 14, Boyer discloses a point management method wherein both service users and service providers are members, an electronic medium is issued to individual members, a need of the service user and a service which the service provider can provide are matched, the matching result is reported to both the subject members (See Boyer, Col.10, lines 35-52).

Boyer does not explicitly disclose that the method having the service provider is guided to a residence of the user by a navigation system, points are provided for the

Art Unit: 3626

service provider according to the conducted service, the points can be used at available participant stores, and the used points are settled by an operating body.

However, this feature is known in the art, as evidenced by Bednarek. In particular, Bednarek suggests that the method having the service provider is guided to a residence of the user by a navigation system, points are provided for the service provider according to the conducted service, the points can be used at available participant stores, and the used points are settled by an operating body (See Bednarek, Col.63, lines 39-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bednarek within the system of Boyer with the motivation of providing existing reward programs such as airline reward programs, credit card reward programs point of purchase reward, internet loyalty reward programs and like .Base points (BP) can be any form of accumulated reward, including for example airline miles, cash awards, ClickRewards, point, accumulated winnings, accumulated losses, etc. (See Bednarek, Col.18, lines 61-67).

(J) Claims 15-20 recite the underlying process steps of the elements of claims 8-13, respectively. As the various elements of claims 8-13 and have been shown to be either disclosed by or obvious in view of the collective teachings of Boyer and Bednarek, it is apparent that the methods disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 15-20 are rejected for the same reasons given above for the method claims 8-13, and incorporated herein.

**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches system for establishing and administering funded and post-funded charge accounts (5,583,760) and system and method for processing multiple electronic transaction requests (5,878,215).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F  
V.F

Application/Control Number: 10/045,022

Page 11

Art Unit: 3626

May 13, 2006

  
C. LUKE GILLIGAN  
PATENT EXAMINER